REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed January 13, 2005. In the Office Action, the Examiner notes that claims 1-14, 16-29 and 31-41 are pending and rejected. However, the Applicants note that as of the previous response, filed 8/12/04, claims 1-14, 16-29 and 31-42 were pending. By this response, claims 1, 16 and 41 have been amended, claims 7-14, 22-29 and 31-40 have been deleted; and claims 43 and 44 have been added. The amendments to the claims and the new claims are fully supported by the Specification. For example, the amendments to the claims are supported at least by page 37, line 22, through page 38, line 1, and by page 34, lines 6-25, of the Specification. Newly added claim 43 is supported at least by page 38, lines 12-14. Newly added claim 44 is supported at least by page 37, lines 14-16. Thus, no new matter has been added, and the Examiner is respectfully requested to enter the amendments to the claims and the newly added claims.

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

Amendments to the Specification

The Specification has been amended to clarify that U.S. Patent Application No. 08/160,194 is now U.S. Patent No. 5,990,927; U.S. Patent Application. No. 08/160,281 is now U.S. Patent No. 5,798,785; U.S. Patent Application No. 08/160,280 is now U.S. Patent No. 5,600,364; U.S. Patent Application No. 08/160,282 is now U.S. Patent No. 5,659,350; U.S. Patent Application No. 08/160,193 is now U.S. Patent No. 5,734,853; and that U.S. Patent Application No. 08/160,283 is now U.S. Patent No. 5,682,195.

Rejections

35 U.S.C. §103

Claims 1-6, 16-21, 27-29, 31-42

The Examiner has rejected claims 1-6, 16-21, 27-29, 31-42 under 35 U.S.C. §103(a) as being unpatentable over Florin (U.S. Patent No. 5,621,456, hereinafter "Florin"), in view of Handelman (U.S. Patent No. 5,715,315, hereinafter "Handelman") and Anzelone (U.S. Patent No. 5,162,979, hereinafter "Anzelone") and further in view of Hedger (Broadcast Telesoftware: Experience ORACLE, hereinafter "Hedger"). The Applicants respectfully traverse the rejection.

The Applicants' independent claim 1 recites (emphasis added below):

> "1. A hardware upgrade for enhancing the functionality of a set top converter in a television program delivery system, each set top converter adapted to receive electronic mail and having a microprocessor, the hardware upgrade comprising:
>
> an interface for providing an electrical connection to the set top converter, whereby the electronic mail is transferred from the set top converter for processing and the processed electronic mail is passed to the set top converter for display;
>
> a memory for storing interactive programming instructions that enable a subscriber to engage in textual interactivity with online applications; and
>
> at least one microprocessor connected to said memory and connected to said interface for accessing the stored interactive programming instructions and for processing the electronic mail to produce processed electronic mail based on the stored interactive programming instructions, the microprocessor of the hardware upgrade capable of communicating with the microprocessor of the set top converter through the interface."

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Florin, Handelman, Anzelone and Hedger references alone or in combination fail to teach or suggest the Applicants' invention as a whole.

Specifically, the Florin, Handelman, Anzelone and Hedger, alone or in combination, fail to teach or suggest, inter alia, a "hardware upgrade for enhancing the functionality of a set top converter," a "memory for storing interactive programming instructions" on the hardware upgrade, and "at least one microprocessor connected to said memory and connected to said interface for accessing the stored interactive programming instructions and for processing the electronic mail to produce processed electronic mail based on the stored interactive programming instructions, the microprocessor of the hardware upgrade capable of communicating with the microprocessor of the set top converter through the interface" as recited in the claim as amended.

Florin discloses an interactive audio-visual transceiver which is coupled to, for example, a television and/or telephone cable, a TV, and a VCR. In one embodiment, the transceiver has modules such as a main module including a CPU, an A/V connect module, and an optional CD ROM module. However, Florin does not disclose a hardware upgrade for a set top converter, an interface between the set top converter and the hardware upgrade, and a microprocessor of the hardware upgrade which is capable of communicating with a microprocessor of the set top converter. Furthermore, as the Examiner acknowledges, "[a]s for the step comprising an interface for providing an electrical connection to the STB, whereby the e-mail is transferred from the STB for processing and the processed e-mail is passed to the STB for display, Florin does not discuss any details of the processing of the e-mail services" (page 3, 1/13/05 Office Action).

The Examiner alleges that "[t]he claimed memory for storing interactive programming instructions reads on Florin, col. 8, lines 52-55" (page 4, 1/13/05 Office Action). However, the Applicants respectfully disagree. The cited section of Florin simply discloses: "The main module 62 includes a central processing unit (CPU) 63 coupled over a system bus 64 to a system memory 65 ..." Thus, there is no teaching by Florin in this cited section of a memory to store interactive programming instructions. Simply having a 'system memory 65' coupled to a 'central processing unit (CPU) 63' does not equate to "a memory for storing interactive programming instructions that enable a subscriber to engage in textual interactivity with online applications" as recited

in the claim as amended. Furthermore, Florin does not teach a memory for storing the interactive programming instructions which is part of a hardware upgrade.

The Handelman reference does not bridge the substantial gap between the Florin reference and the Applicants' invention as recited in claim 1. Handelman discloses a CATV interface unit and an external memory unit. The Examiner relies on Handelman to "teach[es] that e-mail data may be transmitted from the CATV interface unit 18 to an external memory unit 38" (page 4, 1/13/05 Office Action). The Examiner also alleges that "[t]he claimed memory for storing interactive programming instructions ... is necessarily included in Handelman, which is directed to a CATV system that enables subscribers interactivity" (page 4, 1/13/05 Office Action). However, the Applicants respectfully disagree. Handelman only discloses using the external memory to store data, which may in one embodiment be incoming email data. This does not necessarily include storing interactive programming instructions, contrary to the Examiner's allegation. In fact, Handelman discloses that "[s]tored faxes, E-mail, voice-mail and mail data are provided by either of the memories 36 and 38 to processor 34 via memory controller 40" (column 6, lines 38-40). Thus, it is believed that the external memory of Handelman is only capable of storing data. Furthermore, as the Examiner acknowledges, "Handelman does not show that the memory card includes a CPU" (page 4, 1/13/05 Office Action).

Anzelone does not bridge the substantial gap between the Florin and Handelman references and the Applicants' invention as recited in claim 1. Anzelone discloses a processor card for a computer system, the processor card having a processor. The Examiner relies on Anzelone to teach the microprocessor of the hardware upgrade. However, Anzelone does not disclose, inter alia, a "microprocessor of the hardware upgrade capable of communicating with the microprocessor of the set top converter through the interface" as recited in the claim. Anzelone does not disclose a processor (which is not on the processor card) with which the processor of the processor card communicates.

Furthermore, "to rely on a reference under 35. U.S.C. 103, it must be analogous art" (see MPEP 2141.01(a)). Anzelone does not represent analogous art because it pertains to a replaceable processor card for a personal computer. However, the

computer of Anzelone is different than the set top converter of the present invention, and is used for a different purpose and does not perform the basic functions of the set top converter. Therefore, it would not be apparent for one of ordinary skill in the art to use the processor card of Anzelone, pertaining to a personal computer, in the art of upgrading a set top converter.

Moreover, there is no motivation to combine Anzelone with Florin, Handelman and the other references. For prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.SQ.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.SQ.2d 1596, 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

Anzelone discloses a processor on a processor card which "allow[s] a user to readily replace the processor card" (column 1, line 56). Anzelone also discloses an object of the processor card is to provide "a novel interconnect system facilitating installation and removal of the card" (column 2, lines 2-3), for example in order to control the force needed to mate the processor card with other components (see column 1, lines 32-42, and column 2, lines 7-11). Anzelone further discloses that another objective of the processor card is a low cost interconnect system (see column 1, lines 43-50, and column 2, lines 4-6 and lines 12-17). Thus, Anzelone is interested in a processor card which is readily replaceable and had a low cost interconnect system.

The Examiner alleges that Anzelone teaches "the desirable advantage of more independent modular systems" (page 5, 1/13/05 Office Action). However, the Applicants respectfully disagree. As discussed above, Anzelone is concerned with the cost and mechanical design of the interconnect system of a card carrying components that are likely to be replaced (see also column 2, lines 31-35). The disclosure of Anzelone would thus not provide motivation to combine the processor or processor card

of Anzelone with the elements of the disclosures of Florin and Handelman to arrive at the teachings of the present invention as recited in claim 1. In contrast, the aims of the present invention include upgrading the capability of a basic set top converter, in part to provide new and increased functionality, and in part to keep the cost of the basic set top converter low. Anzelone does not provide motivation towards increasing the functionality of the computer system of Anzelone with the processor card, nor does Anzelone provide motivation towards lowering the cost of the computer system of Anzelone.

Hedger fails to bridge the substantial gap between the Florin, Handelman, and Anzelone references and the present invention as recited in claim 1. Hedger discloses a teletext receiver which is capable of receiving software from teletext transmissions. The Examiner relies on Hedger to "disclose[s] the benefits of using a textural keyboard, instead of a numeric keypad" (page 5, 1/13/05 Office Action). However, Hedger does not teach or suggest, inter alia, a hardware upgrade for a set top box, the hardware upgrade having a memory for storing interactive programming instructions, and a "microprocessor of the hardware upgrade capable of communicating with the microprocessor of the set top converter through the interface" as recited in the claim and lacking in the other references.

As such, the Applicants submit that independent claims 1, 16 and 41 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2-6, 17-21 and 42 depend, either directly or indirectly, from independent claims 1, 16 and 41 and recite additional features thereof. As such and at least for the same reasons as discussed above, the Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

Claims 7-10, 12-14 and 22-25

The Examiner has rejected claims 7-10, 12-14 and 22-25 under 35 U.S.C. §103(a) as being unpatentable over Kauffman (U.S. Patent No. 5,003,591, hereinafter "Kauffman") in view of Strubbe (U.S. Patent No. 5,223,924, hereinafter "Strubbe") and

Hedger. Claims 7-10, 12-14 and 22-25 have been cancelled and thus this rejection is moot.

Claims 11 and 26

The Examiner has rejected claims 11 and 26 under 35 U.S.C. §103(a) as being unpatentable over Kauffman, Strubbe & Hedger in view of Remillard (U.S. Patent 5,561,709, hereinafter "Remillard"). Claims 11 and 26 have been canceled and thus this rejection is moot.

Newly added claims

Newly added claims 43 and 44 are believed to be patentable because they depend directly on claim 1 which is believed to be patentable for the above-discussed reasons.

CONCLUSION

Thus, the Applicants submit that none of the claims presently in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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